

REMARKS

Rejection Pursuant to 35 U.S.C. 112

Claims 2-9, 14-19, and 63-65 stand rejected pursuant to 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

In the rejection, Examiner asserts that, as was stated in the previous Official Action, the phrase “extended time” is indefinite. Applicant notes that Applicant is under no duty to engage in experimentation to assess a specific endpoint for the degradation of materials that may degrade at a time so extended into the future as to require extreme or extensive testing, nor is Applicant required to engage in experimentation that would lead to a lengthy wait to obtain a patent on the invention. *See, In re Wands*, 858 F.2d 731 (Fed. Cir. 1988). Rather, Applicant is entitled to rely on terminology consistent with the technical specifications of the materials used, which, as stated by Applicant previously, is what Applicant has done with respect to the fabrics and inks used, as evidenced by the technical specifications previously submitted. *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372 (Fed. Cir. 2000). Applicant respectfully submits that Applicant has used the subject terminology in a manner that would be readily understandable to one skilled in the art and that is consistent with the common use of such terminology in the art, particularly in light of the reference materials available to one skilled in the art as cited by Applicant. Further, Applicant has defined these terms in such a way that the terms illustrate that the degradation characteristics of the subject medicinal pads and inks are patentably differentiable from the prior art. *See, Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d

1565 (Fed. Cir. 1986). *See also, Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613 (Fed. Cir. 1985).

Rejection Pursuant to 35 U.S.C. 103(a)

Claims 2-9, 14-19, and 63-65 stand rejected pursuant to 35 U.S.C. 103(a) as being unpatentable over McFarland or Schleinz in view of Danippon, Hayashi, or Morikawa and Desie, as set forth in the previous action.

In the Action, Examiner notes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination. Applicant wholeheartedly agrees with Examiner on this point.

Examiner asserts, in part, that in some cases a motivation to combine, where not explicitly taught in the prior art, may be generated due to the nature of a problem to be solved. However, the cases cited by Examiner in support of this proposition do not hold in accordance with the statements made by Examiner. Regardless of whether the suggestion or motivation to combine references is found explicitly or implicitly within the cited references, the Examiner must explain, by citation to proper references, the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. Simply stating that a motivation exists is not enough. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). In *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002), the Court of Appeals for the Federal Circuit reversed the Board's decision, stating:

" 'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. ***The board cannot rely on conclusory statements when dealing with particular***

combinations of prior art and specific claims, but must set forth the rationale on which it relies."

MPEP §2144.03A citing *Lee* at 1344-45. (emphasis added)

Were Examiner's characterization of these court cases true, any long felt need or problem to be solved would, in fact, NOT lead to patentable subject matter, but rather would be cause for rejection. If such were the case, inventors would not be incentivized to create inventions to solve long felt problems, and in fact would be disincentivized to solve long felt needs because, in fact, solving a long felt need would be a reason for rejection. This, of course, would fly directly in the face of nearly every public policy motivation for patent law in the United States. For example, according to Examiner's characterization of the current state of U.S. patent law, since a cure for cancer would clearly be motivated by the nature of the problem to be solved, particularly in that the need has been long felt, such a cure would not be patentable, and in fact would be properly rejected because the nature of the problem to be solved is clear to all those attempting to solve the problem. Such a result, of course, would be absurd and completely contrary to our patent laws.

In light of the above, Applicant **again respectfully requests** that Examiner provide a proper teaching of motivation, other than Examiner's own stated feelings on the prior art, that would lead to the creation of a pad having the characteristics of the present invention, which pad, as illustrated in the previously submitted Declaration, has solved an admittedly long felt need. **To date, the examiner has cited no support, other than his own "position", for any of the combinations suggested, nor has the examiner provided an illustration that the references combined as cited would produce a pad having the characteristics claimed in the present invention.** Rather, Examiner has repeatedly asserted what the Examiner's **unsupported**

“position” is, and such assertions are not grounds for a proper rejection pursuant to 35 U.S.C.

103. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

Applicant reminds Examiner that, without taking judicial notice, Examiner’s own feelings on teachings do NOT qualify as impressions or teachings of or to one of ordinary skill in the art that can be cited in rejecting otherwise patentable subject matter. *See, In re Gartside*, 203 F.3d 1305. *See also, In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). Further, Applicant reminds Examiner that Applicant has **repeatedly requested** that either Examiner take judicial notice, and state specific reasons and support, **other than Examiner’s own “position”**, why such notice is being taken, or that Examiner provide, from **specific citation to cited references**, the teaching that would motivate one skilled in the art to combine the cited references in a way that would make the present invention, as claimed, obvious.

Additionally, Applicant notes that Examiner has now cited six references in the 103 rejection. Without a suggestion or motivation to combine the cited references **as found within the cited references themselves**, the continuing need to add more references in order to make a rejection would seem to imply that, in fact, the reference DO NOT TEACH the claimed combination. Applicant further submits that the need to cite such a vast myriad of references in order to reach a conclusion of obviousness should lead an Examiner to conclude that the required suggestion or motivation to combine the cited references is, in fact, absent, and that the invention is, indeed, not obvious.

Applicant’s Declaration

Applicant notes that Examiner states that “it is the examiner’s position that the proposed combination meets the properties claimed by applicant . . .” in order to overcome

Applicant's Declaration of a long felt need for the instant invention. Applicant notes, that were the mere taking of a "position" by Examiner, which position had already been taken by Examiner, enough to overcome a Declaration by one of ordinary skill in the art, Declaration practice in the U.S. Patent Office would officially be moot. As such, in light of the fact that Applicant has submitted a Declaration from one of ordinary skill in the art that a long felt need existed and is solved by the instant invention, Applicant **again** respectfully requests that Examiner produce a citation to a teaching evidencing that one of ordinary skill in the art had NOT experienced a long felt need, or that the pad of the instant invention as claimed did not meet the long felt need.


Finally, Applicant notes that no teaching produced by the examiner suggests a combination of the specific inks and pads as claimed by Applicant or as averred in Applicant's Declaration. Teachings of the general use of inks and pads in the prior art that attempt to avoid leaching or degradation, and teachings that in actuality show the repeated failure of prior combinations to produce the desired characteristics, illustrate that the present invention as claimed is **patentable**, rather than, unpatentable.

Conclusion

Applicant respectfully requests consideration of the subject application in light of the reasons set forth herein. Consequently, a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,

REED SMITH LLP

A handwritten signature in black ink, appearing to read 'Thomas J. McWilliams', is written over a horizontal line.

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